

Remarks/Arguments

The foregoing amendments to the claims are of formal nature, and do not add new matter. Claims 39-47 and 49-51 are pending in this application and were rejected on various grounds. Claims 39-43 have been amended with the functional recitation suggested by the Examiner. Applicants thank the Examiner for indicating allowable subject matter and withdrawing some objections/rejections; the rejections to the presently pending claims are respectfully traversed.

Priority

The Examiner stated that Applicants were entitled to the effective filing date of 9/16/98 based on the disclosed utility of the chondrocyte re-differentiation assay in Example 95, Assay 110. Applicants submit that they would like to rely on the related chondrocyte proliferation assay (Example 99, Assay 111) for utility, which is also disclosed in PCT Application No. PCT/US98/19330, filed 9/16/98. Applicants have amended the claims to reflect this utility and submit that this is a specific, substantial and credible asserted utility.

Claim Rejections – 35 USC § 112/ Second paragraph

Claims 39-47, 49-51 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for still reciting part (b) that recites "the polypeptide,.....lacking its associated signal sequence".

Applicants submit that this recitation is definite because Figure 46 clearly discloses that the signal sequence is from amino acid 1-30. Hence, a person skilled in the relevant art would know exactly what was meant by "the amino acid sequence of the polypeptide shown in Figure 46 (SEQ ID NO:127), lacking its associated signal peptide" recited in part (b) of the claims.

Accordingly this rejection should be withdrawn.

Claim Rejections – 35 USC § 112/Enablement

Claims 39-51 were rejected under 35 U.S.C. §112, first paragraph, for lack of enablement of the "NCI tumor assay" in the specification.

The Examiner acknowledged that the specification is fully enabled as of the priority date of 9/16/98 for redifferentiation of chondrocytes (Example 99, assay 111). Without acquiescing to the Examiner's position regarding the NCI tumor screening assay, Applicants have amended the claims to recite the "induction of chondrocyte redifferentiation. Hence, Applicants submit that this 35 U.S.C. § 112, first paragraph enablement rejection should be withdrawn.

Claim rejection- 35 U.S.C. § 102

Claims 39-47 are rejected under 35 USC § 102(b) as being anticipated by Kato et al (WO 99/43802, dated 9/1999).

As discussed above, the effective filing date for this application is 9/16/98 which is before the 9/1999 date of the cited prior art. Hence, WO 99/43802 is not prior art and this rejection should be withdrawn.

Claim rejection- 35 U.S.C. § 103

Claims 50 and 51 are rejected under 35 USC § 103 as being unpatentable over Kato et al (WO 99/43802, dated 9/1999) in view of Boyle, U.S.P.N. 6,284,485B1.

As discussed above, the primary reference Kato is not prior art since it is dated after the effective filing date of the present application. Accordingly, this rejection falls and hence, this rejection should be withdrawn.

Claim objection

Claim 49 was objected to for depending from a rejected claim.

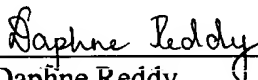
Since Claim 44, upon which 49 depends, is now free of the 102(b) prior art as discussed above, Applicants believe that Claim 44 should not be a rejected claim. Accordingly, the objection to claim 49 should be withdrawn.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39780-1618P2C13). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: October 24, 2003


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